

REMARKS

By this Amendment, Applicants cancel claims 5 and 17-19, without prejudice or disclaimer; amend claims 1, 3, 10, and 13 to more appropriately claim the invention; rewrite claim 6 in independent form; and amend claims 7-9 to depend upon independent claim 6. Claims 1-4 and 6-16 remain pending.

In the last Office Action, the Examiner objected to drawings filed on January 7, 2004, and rejected claims 1-19 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,889,649 ("*Nabetani*") in view of U.S. Patent No. 5,913,174 ("*Casarez*").

OBJECTION TO DRAWINGS

In the last Office Action, the Examiner objected to drawings filed on January 7, 2004. However, Applicants did not file any drawings on January 7, 2004. Applicants filed a replacement drawing for FIGs. 7 and 8 on December 30, 2003.

Assuming the Examiner's objection is referring to the replacement drawing of December 30, 2003, Applicants request that the Examiner please indicate with specificity the grounds for the objection. The last Office Action did not state any reason for the objection. If the Examiner did not intend to make the objection, Applicants request that the objection be withdrawn and the drawing filed on December 30th be accepted.

CLAIMS 1-4

Applicants respectfully traverse the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez* because the Examiner has failed to present a *prima facie* case of obviousness. To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, the Examiner must show some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success. Finally, the Examiner must show that the prior reference(s) teaches or suggests all claim elements. M.P.E.P. § 2143 (8th Ed., Feb. 2003).

The rejection of claim 1 under 35 U.S.C. § 103(a) fails to meet the above three basic criteria. Particularly, *Nabetani* and *Casarez* fail to teach or suggest, separately or in combination, an electronic apparatus including, as recited in amended claim 1, at least a holding portion which detachably holds a radio communication card including an antenna, and a shielding plate on which the holding portion is provided, whereby the holding portion is arranged to hold the radio communication card in a manner such that the antenna is located outside of the holding portion and the minimum distance between the antenna and the shielding plate is 1 mm or more.

In contrast, *Nabetani* merely discloses an adapter 2 for interfacing a memory card 3 with a computer 1 via a storage medium holder 1-1 (FIG. 3). And, *Casarez* merely discloses a card radio 2 having a removable, interchangeable antenna 1 or 99 (FIGs. 1 and 29). *Nabetani* and *Casarez* do not teach or suggest anything related to a shielding plate. Neither do they teach or suggest at least a holding portion arranged to hold a radio communication card such that an antenna included in the card is at a minimum distance of at least 1 mm from the shielding plate.

Further, the Examiner on page 2 of the Office Action, alleges that *Nabetani* discloses a metal plate on which a holding portion is provided (FIG. 16). However, *Nabetani* merely discloses a printed circuit board 119 on which holder 114 is mounted.

Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez* can not be sustained because *Nabetani* and *Casarez* do not teach or suggest, separately or in combination, each and every element of claim 1.

Further, the rejection of claims 2-4 under 35 U.S.C. § 103(a) can not be sustained at least by virtue of their dependence upon allowable claim 1, in addition to the patentable subject matter recited therein.

CLAIMS 5-9

Applicants respectfully traverse the rejection of claim 5 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez*. However, to advance the prosecution of the present application, Applicants have canceled claim 5 without prejudice or disclaimer. Accordingly, the rejection of claim 5 under 35 U.S.C. § 103(a) is moot. Applicants reserve the right to pursue the subject matter recited in claim 5 at a later time, such as in a continuation application.

Applicants respectfully traverse the rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez*. *Nabetani* and *Casarez* fail to teach or suggest, separately or in combination, at least a holding portion including a preventing portion which prevents a radio communication card from being set in a manner such that a first surface opposite to an installation surface on an apparatus

body and a second surface on a radio communication card face opposite directions, as recited in current claim 6.

The Examiner alleges, on page 4 of the Office Action, that FIG. 9 and 6:14-60 of *Nabetani* discloses a holding portion and a preventing portion. However, *Nabetani* merely teaches an ejecting operating member 8 and a locking portion 12-1 in a holding member 1-1 (6:44-56). Ejecting operating member 8 and locking portion 12-1 do not prevent a card from being set in a manner such that a first surface opposite to an installation surface on an apparatus body and a second surface on a radio communication card face opposite directions. Ejecting operating member 8 and locking portion 12-1 merely provide a mechanism for ejecting or locking a storage medium adapter 2. *Casarez*, separately or in combination, does not overcome this deficiency of *Nabetani*.

Accordingly, the rejection of claim 6 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez* can not be sustained because *Nabetani* and *Casarez* do not teach or suggest, separately or in combination, every element of claim 6.

Further, the rejection of claims 7-9 under 35 U.S.C. § 103(a) can not be sustained at least by virtue of their dependence upon allowable claim 6, in addition to the patentable subject matter recited therein.

CLAIMS 10-12

Applicants respectfully traverse the rejection of claim 10 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez*. *Nabetani* and *Casarez* fail to teach or suggest, separately or in combination, at least a holding portion being arranged to hold a radio communication card in a manner such that an antenna of the

radio communication card is located outside of an apparatus body and situated farther from an installation surface of the apparatus body than a center of the apparatus body with respect to a direction perpendicular to the installation surface of the apparatus body, as recited in current claim 10.

The Examiner alleges, on page 5 of the Office Action, that FIGS. 10 and 16 and 10:45 to 11:42 of *Nabetani* disclose situating an antenna with respect to an installation surface. However, *Nabetani* merely teaches a seat coil 118 (11:6-7). Seat coil 118 is not arranged to hold a radio communication card in a manner such that an antenna of the radio communication card is located outside of an apparatus body and situated farther from an installation surface of the apparatus body than a center of the apparatus body with respect to a direction perpendicular to the installation surface of the apparatus body. *Casarez*, separately or in combination, does not overcome this deficiency of *Nabetani*.

Accordingly, the rejection of claim 10 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez* can not be sustained because *Nabetani* and *Casarez* do not teach or suggest, separately or in combination, every element of claim 10.

Further, the rejection of claims 11 and 12 under 35 U.S.C. § 103(a) can not be sustained at least by virtue of their dependence upon allowable claim 10, in addition to the patentable subject matter recited therein.

CLAIMS 13-16

Applicants respectfully traverse the rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez*. *Nabetani* and *Casarez* fail to teach or suggest, separately or in combination, at least a cover removably fitted to an

apparatus body and covering at least a portion of a radio communication card extending outside the apparatus body and a holding portion when the radio communication card is set in position, as recited in amended claim 13.

The Examiner alleges, on page 5 of the Office Action, that FIGS. 4 and 10 and 6:28 to 7:41 of *Nabetani* discloses an adapter 2 as a cover. However, *Nabetani* does not teach using adapter 2 as a cover removably fitted to an apparatus body and covering at least a portion of a radio communication card extending outside the apparatus body and a holding portion when the radio communication card is set in position. *Casarez*, separately or in combination, does not overcome this deficiency of *Nabetani*.

Accordingly, the rejection of claim 13 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez* can not be sustained because *Nabetani* and *Casarez* do not teach or suggest, separately or in combination, every element of claim 13.

Further, the rejection of claims 14-16 under 35 U.S.C. § 103(a) can not be sustained at least by virtue of their dependence upon allowable claim 13, in addition to the patentable subject matter recited therein.

CLAIMS 17-19

Applicants respectfully traverse the rejection of claims 17-19 under 35 U.S.C. § 103(a) as unpatentable over *Nabetani* in view of *Casarez*. However, to advance the prosecution of the present application, Applicants have canceled claims 17-19 without prejudice or disclaimer. Accordingly, the rejection of claims 17-19 under 35 U.S.C. § 103(a) is moot. Applicants reserve the right to pursue the subject matter recited in claims 17-19 at a later time, such as in a continuation application.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of pending claims 1-4 and 6-16.

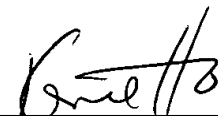
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 30, 2004

By: _____



Kenie Ho
Reg. No. 51,808